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OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			EXAMINER PHAM, MICHAEL	
			ART UNIT 2167	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

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Office Action Summary

Application No.

10/821,949

Applicant(s)

MARTIN ET AL.

Examiner

Michael D. Pham

Art Unit

2167

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 March 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-48 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2-48 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Status

1. Claims 2-48 are pending.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 2 – 8, 14, 17, 20, 22 – 23, 25 – 27, 38 – 39, 42 – 44 and 47 – 48 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Maxham et al.** (hereinafter **Maxham**, US 2004/0187075) in view of **Koppich** (US 2005/0141028).

4. Regarding claims 2, 47, and 48 **Maxham** teaches a method of, system for, and computer program product for profiling electronically-stored data, comprising: accessing data from one or more data archives, said one or more data archives located on one or more electronic archive devices (See page 3, paragraph [0034] “If in electronic form, a suitable drive 26 corresponding to the medium type is used to upload electronic documents to the computer system 10.”);

transferring a file from said accessed data to a working electronic folder (See page 2, paragraph [0035] “First, data is loaded into the computer system 10 via workstation 12.”);

tagging the working electronic folder with folder meta-data (See page 5, paragraph [0049] “FIG 6c shows the attribute menu. Here, various attributes may be assigned to documents selected.”);

converting said selected file (See page 3, paragraph [0037] “After the documents to be uploaded have been de-duplicated, extractor 220, converts each native document...”), said step of converting including

extracting file meta-data from said selected file into a corresponding meta-data file (See page 3, paragraph [0037] “Other files that may be generated include meta data files 226...”);

extracting a user-selectable portion of text from said selected file into a corresponding selected text file (See page 3, paragraph [0037] “After the documents to be uploaded have been de-duplicated, extractor 220, converts each native document 222 (corresponding to the input files in original format) to at least a text file 224.”);

creating an image of said selected file (See page 3, paragraph [0037] “Other files that may be generated included meta data files, XML files, and HTML files. Well known third party software packages may be used in this conversion process.” A document converted to an HTML file can be considered an image of the selected file. Also, some of the third party software packages referred to in the reference include things such as pdf type images of the files.), and

appending the corresponding meta-data file to said image of said selected file to create an appended image file. (See page 3, paragraph [0038] “Indexer 232 creates a file association table for each native document that maintains the association between each native document 222, converted documents 224-230, and attachments, if any, to the native documents.”)

Maxham does not explicitly disclose processing the contents of said electronic folder, said step of processing including identifying whether a file within said electronic folder can be converted; and selecting a file that can be converted in said processing step. However, **Koppich** discloses processing the contents of said electronic folder, said step of processing including identifying whether a file within said electronic folder can be converted (See page 4, paragraph [0044] "...the document management system includes means adapted for determining whether the selected operations or script are able to be executed."); and selecting a file that can be converted in said processing step (See page 5, paragraph [0047] "...converting any documents in the data storage area from a first selected file format to a selected second selected file format...").

It would have been obvious to one with ordinary skill in the art at the time of the invention to combine the teachings of **Maxham** with that of **Koppich** because both are related to document management systems and by including the ability to determine which files can be converted as disclosed in **Koppich**, the method is better able to process the files by not trying to convert certain types of files that are not able to be converted. It is for this reason that one of ordinary skill in the art would have been motivated to include processing the contents of said electronic folder, said step of processing including identifying whether a file within said electronic folder can be converted and selecting a file that can be converted in said processing step.

5. Regarding claim 3, the combination of **Maxham** and **Koppich** disclose exporting one of said appended image file and said selected text file. (See **Maxham** page 5, paragraph [0052]

“When a user selects the document the converted text, html, or xml file is displayed.” And see FIGS. 10a-b, showing the exporting of the files to a viewer in the form of a web browser.)

6. Regarding claim 4, the combination of **Maxham** and **Koppich** disclose a step of: displaying one of said steps of accessing, transferring, tagging, processing, selecting, and converting. (See **Maxham** page 5, paragraph [0048] “FIG. 5 illustrates an example of a webpage displayed when the My Files tab 418 has been selected. As shown, both user-associated files, as well as files categorized in public folders.” And see **Maxham** page 5, paragraph [0054] “Also displayed are links 1014 to children files, i.e., files that were attached to the native document, which the user may select.”)

7. Regarding claim 5, the combination of **Maxham** and **Koppich** disclose displaying a series of parent-child relationships between a file and an attachment to said file. (See **Maxham** page 3, paragraph [0038] “Indexer 232 creates a file association table for each native document that maintains the association between each native document 222, converted documents 224-230, and attachments, if any, to the native documents. These attachments commonly referred to as ‘children files’.”)

8. Regarding claim 6, the combination of **Maxham** and **Koppich** disclose said attachment comprises: a second attachment to said attachment. (See **Maxham** page 3, paragraph [0038] “Indexer 232 creates a file association table for each native document that maintains the association between each native document 222, converted documents 224-230, and attachments,

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if any, to the native documents.” The two attachments are the converted documents and any other attachments, as mentioned in the above quotation.)

9. Regarding claim 7, the combination of **Maxham** and **Koppich** additionally discloses said folder metadata comprises: date created, last date opened, last date modified, creator name, matter name, and predetermined identification and quality control data. (See **Koppich** page 5, paragraph [0056] “The search criteria includes at least one of keywords, indices, electronic document size, electronic document creation date, electronic document name, electronic document content, and electronic document creator name.”)

10. Regarding claim 8, the combination of **Maxham** and **Koppich** additionally discloses said step of processing further comprises: identifying a duplication within said working electronic folder. (See **Maxham** page 2, paragraph [0013] “The computer is configured to...eliminate duplicate native documents based on the unique identification tags, for producing a subset of input files to be uploaded to the plurality of computer nodes.”)

11. Regarding claim 14, the combination of **Maxham** and **Koppich** additionally discloses said step of identifying a duplication comprises: identifying said duplication by a hash or another unique identifier. (See **Maxham** page 3, paragraph [0036] “Well known cryptographic algorithms, such as the MD5 checksum, may be used to create a fingerprint unique to each file.” MD5 is a hash algorithm.)

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12. Regarding claim 17, the combination of **Maxham** and **Koppich** additionally discloses said step of identifying a duplication comprises: identifying a duplication by an MD5 hash algorithm. (See **Maxham** page 3, paragraph [0036] “Well known cryptographic algorithms, such as the MD5 checksum, may be used to create a fingerprint unique to each file.” MD5 is a hash algorithm.)

13. Regarding claim 20, the combination of **Maxham** and **Koppich** additionally discloses said step of converting comprises one of: creating a searchable master text file [index] containing the contents of all selected files; time stamping or digitally authenticating the searchable master text file; and appending selected meta-data about the files included in the master text file. (See **Maxham** page 2, paragraph [0014] “...each of a plurality of documents having at least one of either meta-data text or attachments identified for retrieval that are indexed for web based retrieval from the cluster database, said identification of the plurality of documents forming a cluster data base that is web-searchable by use of a predetermined descriptive term.”)

14. Regarding claim 22, the combination of **Maxham** and **Koppich** additionally discloses said step of extracting selected file meta-data comprises: extracting one of file content data, content header information, file meta-data, file type information, and file characteristic data. (See **Maxham** page 3, paragraph [0035] “Next, the file type discriminator determines file types based on the file extension of each input file...Again, the file type of the extracted documents are determined by the file type discriminator.”)

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15. Regarding claim 23, the combination of **Maxham** and **Koppich** additionally discloses said selected file meta-data comprises: predetermined categories of meta-data corresponding to a file-type. (See **Maxham** page 4, paragraph [0046] “The attribute table may be created by the file type categorizer 216 of FIG. 2 when uploading native documents.”)

16. Regarding claim 25, the combination of **Maxham** and **Koppich** additionally discloses said step of extracting a user-selectable portion of text comprises: creating an ASCII file of said user-selectable portion of text. (See **Maxham** page 2, paragraph [0014] “...where each document is identified by its file extension that is converted to ASCII text and given a unique identification number...”)

17. Regarding claim 26, the combination of **Maxham** and **Koppich** additionally discloses said step of extracting a user-selectable portion of text further comprises: converting said image of said selected file to text with an OCR program if an ASCII file cannot be created. (See **Koppich** page 5, paragraph [0051] “The OCR operation extracts text from image format documents received into the selected data storage area, performs optical character recognition on such documents, and converts them to text...”)

18. Regarding claim 27, the combination of **Maxham** and **Koppich** additionally discloses said step of extracting a user-selectable portion of text comprises: searching for a key word. (See **Koppich** page 5, paragraph [0056] “The search criteria include at least one of keywords, indices, electronic document size, electronic document content, and electronic document creator.”)

19. Regarding claim 38, the combination of **Maxham** and **Koppich** additionally discloses said step of creating an image of said selected file comprises: imaging with a TIFFing driver. (See **Koppich** page 5, paragraph [0050] “ Preferably, the documents are able to be converted from ...PS to TIFF...”)

20. Regarding claim 39, the combination of **Maxham** and **Koppich** additionally discloses said step of exporting comprises: exporting [displaying] to at least one of an image viewer, a printer, and a computer configured to search the corresponding meta-data or a master file text content. (See **Maxham** page 5, paragraph [0052] “When a user selects the document, the converted text, html, or xml file is displayed”)

21. Regarding claim 42, the combination of **Maxham** and **Koppich** additionally discloses said step of accessing comprises: pre-filtering said data with pre-filtering criteria. (See **Maxham** page 3, paragraph [0035] “Next, the file type discriminator 212 determines file types based on the file extension of each input file 210. If the file is an archive, such as .zip, .tar, etc, archive extractor 214 extracts archived file(s)...” Here, the filtering is based on the file type.)

22. Regarding claim 43, the combination of **Maxham** and **Koppich** additionally discloses said step of pre-filtering comprises: pre-filtering based on file content, content header information, file meta-data, file type, or other criteria identified by the user. (See **Maxham** page 3, paragraph [0035] “Next, the file type discriminator 212 determines file types based on the file

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extension of each input file 210. If the file is an archive, such as .zip, .tar, etc, archive extractor 214 extracts archived file(s)..." Here, the filtering is based on the file time.)

23. Regarding claim 44, the combination of **Maxham** and **Koppich** additionally discloses said step of pre-filtering comprises: saving said pre-filtering criteria. (See **Maxham** page 4, paragraph [0042] "Also, document classifications may be assigned to each document on the same scale. Therefore, only documents that have document classification equal to or less than the user's predefined permission level may be viewed by the user." Here, the filtering is the document permissions, and they are stored in the table as shown.)

24. Claims 9 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Maxham** in view of **Koppich** as applied to claim 2 above, and further in view of **Shaughnessy et al.** (hereinafter **Shaughnessy**, US 2004/0205664).

25. Regarding claim 9, **Maxham** and **Koppich** teach a method substantially as claimed. **Maxham** and **Koppich** fail to explicitly disclose said step of processing further comprises: marking a file that cannot be converted as an exception file. However, **Shaughnessy** discloses said step of processing further comprises: marking a file that cannot be converted as an exception file. (See page 26, paragraph [0435] "If the Verity code 454 is unable to convert the selected file to HTML, a server exception will be thrown, and a helpful error message displayed in the user's Netscape browser 12.") It would have been obvious to one with ordinary skill in the art at the time of the invention to combine **Maxham** and **Koppich** with that of **Shaughnessy** because all

three are related to document management and by adding the exception as disclosed in **Shaughnessy**, the method is able to handle files that are not automatically convertible, without failing. It is for this reason that one of ordinary skill in the art would have been motivated to include said step of processing further comprises: marking a file that cannot be converted as an exception file.

26. Regarding claim 10, the combination of **Maxham**, **Koppich** and **Shaughnessy** discloses said step of transferring comprises: transferring via a drag-and-drop user interface comprising one of a computer mouse and a pointing device. (See **Shaughnessy** page 23, paragraph [0362] “2. User selects an existing PowerPoint 97 (.PPT) file from the local hard drive and drags/drops it into the upload control.”)

27. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over **Maxham** and **Koppich** as applied to claim 2 above, and further in view of **Howard** (US 6,098,079). **Maxham** and **Koppich** teach a method substantially as claimed. **Maxham** and **Koppich** fail to explicitly disclose a time-stamped audit file [journal file] configured to record a file history spanning file creation to file destruction. However, **Howard** discloses a time-stamped audit file configured to record a file history spanning file creation to file destruction. (See column 2, lines 48 – 52 and column 2 line 65 – column 3 line 4 “The reconciliation technique uses a set of journal files in which the history of file creation, modification, and deletion throughout the system is recorded, each journal file maintaining the portion of the history involving a particular site, or storage location....The process generally works by ‘merging’ the sequences of version entries in each journal to reconstruct the creation/modification/deletion history for each file at the involved sites.

Dates and time values, referred to as ‘timestamps’, in the journal entries are used in this merging process to place the events from the different journals in order.”) It would have been obvious to one with ordinary skill in the art at the time of the invention to combine **Maxham** and **Koppich** with that of **Howard** because all three references are related to document management between different file systems and by including the audit file and time stamping as disclosed in Howard, the method is able to better track the various files for a more efficient method. It is for this reason that one of ordinary skill in the art would have been motivated to include a time-stamped audit file [journal file] configured to record a file history spanning file creation to file destruction.

28. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over **Maxham** and **Koppich** as applied to claim 2 above, and further in view of **Chi** (US 5,978,917). **Maxham** and **Koppich** teach a method substantially as claimed. **Maxham** and **Koppich** fail to explicitly disclose said step of processing further comprises one of: checking a file for a virus; removing said virus from said file; checking said file for encoding or encryption; decoding or decrypting said file. However, **Chi** discloses said step of processing further comprises one of: checking a file for a virus; removing said virus from said file; checking said file for encoding or encryption; decoding or decrypting said file. (See column 3, lines 20 – 22 “The present invention provides a generic method for identifying the presence of macro viruses and for eliminating those viruses from infected documents.”) It would have been obvious to one with ordinary skill in the art at the time of the invention to combine the teachings of **Maxham** and **Koppich** with that of **Chi** because the types of files that are managed by **Maxham** and **Koppich** frequently contain macros that can contain viruses, and by including the virus detection and removal as disclosed in **Chi**,

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the files can keep the method from becoming corrupt and allowing only clean files to be managed. It is for this reason that one of ordinary skill in the art would have been motivated to include said step of processing further comprises one of: checking a file for a virus; removing said virus from said file; checking said file for encoding or encryption; decoding or decrypting said file.

29. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over **Maxham** and **Koppich** as applied to claim 2 above, and further in view of **Kumashio** (US 2004/0193631) and in view of **Howard**. **Maxham** and **Koppich** teach a method substantially as claimed. **Maxham** and **Koppich** fail to explicitly disclose said step of processing further comprises: performing page estimation and time stamping/digital authentication of said electronic folder. However **Kumashio** discloses said step of processing further comprises: performing page estimation (See page 10, paragraph [0250] "Thus, data concerning documents (IDs of the documents, names of the documents, the number of pages of each document and thumbnails of the documents) stored in the folders selected by a user from the folders displayed in the region V1 of the page is managed for each document.") It would have been obvious to one with ordinary skill in the art to combine the teachings of **Maxham** and **Koppich** with that of **Kumashio** because all three are related to document management and by including the page estimation as disclosed in **Kumashio**, the user is able to determine approximately how much relevant information is located in the folder, becoming more useful to the user. It is for this reason that one of ordinary skill in the art would have been motivated to include said step of processing further comprises: performing page estimation.

Also, **Howard** discloses time stamping/digital authentication of said electronic folder. (See column 2, lines 48 – 52 and column 2 line 65 – column 3 line 4 “The reconciliation technique uses a set of journal files in which the history of file creation, modification, and deletion throughout the system is recorded, each journal file maintaining the portion of the history involving a particular site, or storage location....The process generally works by ‘merging’ the sequences of version entries in each journal to reconstruct the creation/modification/deletion history for each file at the involved sites. Dates and time values, referred to as ‘timestamps’, in the journal entries are used in this merging process to place the events from the different journals in order.”) It would have been obvious to one with ordinary skill in the art at the time of the invention to combine **Maxham**, **Koppich**, and **Kumashio** with that of **Howard** because all of the references are related to document management between different file systems and by including the time stamping as disclosed in **Howard**, the method is able to better track the various files for a more secure method. It is for this reason that one of ordinary skill in the art would have been motivated to include time stamping/digital authentication of said electronic folder.

30. Claims 15 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Maxham** in view of **Koppich** in view of **Shaughnessy** as applied to claim 9 above, and further in view of **Riss et al.** (hereinafter **Riss**, US 2004/0103367).

31. Regarding claim 15, **Maxham**, **Koppich**, and **Shaughnessy** teach a method substantially as claimed. **Maxham**, **Koppich**, and **Shaughnessy** do not explicitly disclose said file that cannot

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be processed comprises one of: a file with a virus; an encrypted file; an unknown file-type; and a deselected file. However, **Riss** discloses said file that cannot be processed comprises one of: a file with a virus; an encrypted file; an unknown file-type; and a deselected file [remove some files from the list]. (See page 4, paragraph [0060] “A list box (418) may be provided to view all the files that are attached by the user. The user can then choose to remove some files from the list (416) if there has been a mistake made by the user. Some document types such as .vbs, .exe will be restricted to avoid any unknown file types or virus files getting into the system.”) It would have been obvious to one with ordinary skill in the art at the time of the invention to combine the teachings of **Maxham**, **Koppich**, and **Shaughnessy** with that of **Riss** because they are all related to document management or processing and by including the disclosure of **Riss**, the method is more stable and efficiently by excluding the types of files that are not recognized or harmful. It is for this reason that one of ordinary skill in the art would have been motivated to include said file that cannot be processed comprises one of: a file with a virus; an encrypted file; an unknown file-type; and a deselected file.

32. Regarding claim 16, the combination of **Maxham**, **Koppich**, **Shaughnessy**, and **Riss** additionally discloses said step of marking a file that cannot be converted comprises one of: logging said exception file; and exporting said exception file. (See Riss Page 8, paragraph [0171] “Exception messages will be sent out to the Event Log and failed document processing will land up in the Suspended Queue.”)

33. Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over **Maxham** in view of **Koppich** as applied to claim 8 above, and further in view of **Eagle et al.** (hereinafter **Eagle**, US 2003/0145209). **Maxham** and **Koppich** teach a method substantially as claimed. **Maxham** and **Koppich** do not explicitly disclose said step of identifying a duplication comprises: checking a duplicate file for a file corruption; and deleting or exporting a corrupted duplicate file.

However, **Eagle** discloses said step of identifying a duplication comprises: checking a duplicate file for a file corruption [validating]; and deleting or exporting a corrupted duplicate file. (See page 4, paragraph [0048] "...validating original files and/or duplicate files, culling (deleting) files that should not be included in the final duplicates repository...") It would have been obvious to one with ordinary skill in the art at the time of the invention to combine the teachings of **Maxham** and **Koppich** with that of **Eagle** because the references are all related to document processing and by including the file corruption and deletion as disclosed in **Eagle**, the method can become more stable by removing files likely to render the system problematic. It is for this reason that one of ordinary skill in the art would have been motivated to include said step of identifying a duplication comprises: checking a duplicate file for a file corruption; and deleting or exporting a corrupted duplicate file.

34. Claim 19 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Maxham** and **Koppich** as applied to claim 2 above, and further in view of **Howard**.

35. Regarding claim 19, **Maxham** and **Koppich** teach a method substantially as claimed. **Maxham** and **Koppich** do not explicitly disclose said step of converting comprises one of: time

stamping and digitally authenticating both the image and the file of extracted meta-data.

However, **Howard** discloses said step of converting comprises one of: time stamping and digitally authenticating both the image and the file of extracted meta-data. (See column 2, lines 48 – 52 and column 2 line 65 – column 3 line 4 “The reconciliation technique uses a set of journal files in which the history of file creation, modification, and deletion throughout the system is recorded, each journal file maintaining the portion of the history involving a particular site, or storage location....The process generally works by ‘merging’ the sequences of version entries in each journal to reconstruct the creation/modification/deletion history for each file at the involved sites. Dates and time values, referred to as ‘timestamps’, in the journal entries are used in this merging process to place the events from the different journals in order.”) It would have been obvious to one with ordinary skill in the art at the time of the invention to combine **Maxham** and **Koppich** with that of **Howard** because all of the references are related to document management between different file systems and by including the time stamping as disclosed in **Howard**, the method is able to better track the various files for a more secure method. It is for this reason that one of ordinary skill in the art would have been motivated to include said step of converting comprises one of: time stamping and digitally authenticating both the image and the file of extracted meta-data.

36. Regarding claim 21, the combination of **Maxham**, **Koppich**, and **Howard** additionally discloses said step of creating a searchable master text file comprises: creating one or more searchable subordinate text files containing the contents of an operator-selected [identified for retrieval] subset of the selected files (See **Maxham** page 2, paragraph [0014] “...each of a

plurality of documents having at least one of either meta-data text or attachments identified for retrieval...”);

time stamping or digitally authenticating the one or more subordinate text files (See **Howard** column 2, lines 48 – 52 and column 2 line 65 – column 3 line 4 “The reconciliation technique uses a set of journal files in which the history of file creation, modification, and deletion throughout the system is recorded, each journal file maintaining the portion of the history involving a particular site, or storage location....The process generally works by ‘merging’ the sequences of version entries in each journal to reconstruct the creation/modification/deletion history for each file at the involved sites. Dates and time values, referred to as ‘timestamps’, in the journal entries are used in this merging process to place the events from the different journals in order.”) and

appending selected meta-data about the files included in the subordinate text files. (See **Maxham** page 2, paragraph [0014] “...having at least one of either meta-data text or attachments...”)

37. Claim 24 is rejected under 35 U.S.C. 103(a) as being unpatentable over **Maxham** in view of **Koppich** in view of **Howard** as applied to claim 19 above, and further in view of **Gladney** (US 2003/0131241). **Maxham**, **Koppich**, and **Howard** teach a method substantially as claimed. **Maxham**, **Koppich**, and **Howard** do not explicitly disclose said step of time stamping comprises: time stamping with one of UTC time and another predetermined time zone. However, **Gladney** discloses said step of time stamping comprises: time stamping with one of UTC time and another predetermined time zone (See page 6, paragraph [0127] “...the timestamp might be encoded as an 8-byte (long) integer that records the last time the value was updated at the

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primary server that manages the handle value; it might contain elapsed time since 00:00:00 UTC, January 1970 in milliseconds.”) It would have been obvious to one with ordinary skill in the art at the time of the invention to combine the teachings of **Maxham**, **Koppich**, and **Howard** with that of **Gladney** because all of the references are related to document profiling and by including the time stamping feature as disclosed in **Gladney**, the method can be more accurate by always having the standard timestamp apply. It is for this reason that one of ordinary skill in the art would have been motivated to include said step of time stamping comprises: time stamping with one of UTC time and another predetermined time zone.

38. Claims 28, 40, 41, 45 and 46 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Maxham** and **Koppich** as applied to claim 2 above, and further in view of **Krachman** (US 2004/0199555).

39. Regarding claim 28, **Maxham** and **Koppich** teach a method substantially as claimed. **Maxham** and **Koppich** do not explicitly disclose said step of extracting a user-selectable portion of text comprises: extracting a portion of text around said keyword. However, **Krachman** discloses said step of extracting a user-selectable portion of text comprises: extracting a portion of text around said keyword. (See page 6, paragraph [0132] “The first item on that hit list will be displayed in the third portion of the screen in a format that showed 30-40 words around highlighted text illustrating the words the search agent found responsive to the query.”) It would have been obvious to one with ordinary skill in the art to combine **Maxham** and **Koppich** with that of **Krachman** because the references are all related to electronic document processing, and

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by including the extracting teachings as disclosed in **Krachman**, the method becomes more robust by not just extracting the keyword, but extracting the word in context. It is for this reason that one of ordinary skill in the art would have been motivated to include said step of extracting a user-selectable portion of text comprises: extracting a portion of text around said keyword.

40. Regarding claim 40, the combination of **Maxham**, **Koppich** and **Krachman** additionally discloses said step of exporting comprises: exporting a file comprising a predetermined litigation support software file type. (See **Krachman** page 7, paragraph [0142] “The trained smart agents can be used to extract text and other information from almost anything: they can burrow through ...all ODBC-compliant databases such as Access, Oracle...” Here, Access is the litigation support software.)

41. Regarding claim 41, the combination of **Maxham**, **Koppich** and **Krachman** additionally discloses said predetermined litigation support software file type comprises one of: an IPRO file type, an Opticon file type, a Concordance file type, a Summation file type, a Ringtail file type, a Microsoft Access file type, and a data management file type. (See **Krachman** page 7, paragraph [0142] “The trained smart agents can be used to extract text and other information from almost anything: they can burrow through ...all ODBC-compliant databases such as Access, Oracle...” Here, Access is the litigation support software.)

42. Regarding claim 45, the combination of **Maxham**, **Koppich** and **Krachman** additionally discloses said step of accessing comprises: accessing an email or instant messaging archive. (See

Krachman page 2, paragraph [0045] and [0046] “Active E-mail systems and attachments...Archived documents and E-mail...”)

43. Regarding claim 46, the combination of **Maxham**, **Koppich** and **Krachman** additionally discloses said step of accessing an email or instant message archive comprises: accessing a printable attachment of an email or instant message. (See **Krachman** page 2, paragraph [0045] and [0046] “Active E-mail systems and attachments...Archived documents and E-mail...”)

44. Claims 29 – 32 and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Maxham** and **Koppich** as applied to claim 2 above, and further in view of **Kenner et al.** (hereinafter **Kenner**, US 6,421,726).

45. Regarding claim 29, **Maxham** and **Koppich** teach a method substantially as claimed. **Maxham** and **Koppich** do not explicitly disclose said step of processing comprises: processing with a prioritization scheme keyed to file type. However, **Kenner** discloses said step of processing comprises: processing with a prioritization scheme keyed to file type. (See column 18, lines 39 – 42 “The CODECs are specified in the script in a prioritized order. If the first-listed CODEC is installed on the user terminal, it will be used. If only a lower-listed CODEC is installed, it will be used instead.”) It would have been obvious to one with ordinary skill in the art at the time of the invention to combine the teachings of **Maxham** and **Koppich** with that of **Kenner** because all three references are related to processing data for use and by including the prioritization scheme keyed to the file type, as disclosed in **Kenner**, the proper processor will be

invoked based on the order set by the user, creating an efficient method for the most accurate processing. The fact that **Kenner** is related to multimedia streams rather than text and static image files as in the other two references is not relevant, since the goal of all three references is to process the files in the most efficient way. It is for this reason that one of ordinary skill in the art would have been motivated to include said step of processing comprises: processing with a prioritization scheme keyed to file type.

46. Regarding claim 30, the combination of **Maxham**, **Koppich**, and **Kenner** additionally discloses said step of processing with a prioritization scheme comprises: processing with a plug-in module. (See **Kenner** column 20, lines 9 – 12 “The EMBED statement also specifies parameters to be used by the plug-in for format selection. The plug-in retrieves those parameters comprising a prioritized list of preferred CODECs and file type extensions.” In other words the plug-in contains the list of extensions related to the prioritized way to process the file type.)

47. Regarding claim 31, the combination of **Maxham**, **Koppich**, and **Kenner** additionally discloses said step of processing with a plug-in module comprises: processing with a plug-in module configured to be selected to be ‘ON’ or ‘OFF.’ (See **Kenner** column 20, lines 3 – 8 “If the plug-in is already present, or the user has taken the appropriate steps to install it, the plug-in is then invoked by the embedded script.” The plug in would be considered to be “ON” if it is installed, and if not installed, it would be considered to be “OFF”.)

48. Regarding claim 32, the combination of **Maxham**, **Koppich**, and **Kenner** additionally discloses said step of processing with a plug-in module comprises; processing with a plug-in module configured to have a user-selectable priority. (See **Kenner** column 19, lines 26 – 28 “In a like manner, different CODEC programs can be selected for use with the different browser environments.” Here, the user selects with plug-in works best for the particular browser and sets the priority accordingly.)

49. Regarding claim 35, the combination of **Maxham**, **Koppich**, and **Kenner** additionally discloses said step of processing with a plug-in module comprises one of: processing with a plug-in configured to open multiple file types (See **Maxham** page 3, paragraph [0035] “If the file type is an archive, such as .zip, .tar, etc., archive extractor extracts archived file(s).” Here, there are multiple file types being processed with the archive extractor.);

processing with multiple plug-ins configured to open a single file-type (See **Kenner** column 19, lines 26 – 28 “In a like manner, different CODEC programs [plug-ins] can be selected for use with different browser environments.” In this case, the same file might be processed using different plug-ins depending upon the browser.)

processing with a plug-in created by incorporating a library of a commercially available software product (See **Maxham** page 3, paragraph [0037] “Well known third party software packages may be used in this conversion process.”); and

processing with a plug-in comprising a library of programming code that incorporates functionality of a third party library or an application to load, image and extract metadata from a

document. (See **Maxham** page 3, paragraph [0037] “Well known third party software packages may be used in this conversion process.”)

50. Claims 33 – 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Maxham** in view of **Koppich** and in view of **Kenner** as applied to claim 29 above, and further in view of **Black et al.** (hereinafter **Black**, US 2002/0059317).

51. Regarding claim 33, **Maxham**, **Koppich**, and **Kenner** teach a method substantially as claimed. **Maxham**, **Koppich**, and **Kenner** do not explicitly disclose said step of processing with a prioritization scheme keyed to file type comprises at least one of: identifying a file type extension; and evaluating a binary file header.

However, **Black** discloses said step of processing with a prioritization scheme keyed to file type comprises at least one of: identifying a file type extension; and evaluating a binary file header. (See page 4, paragraph [0060] “One way to achieve that is to use a combination of file extensions and/or internal binary header information to determine the file type.”)

It would have been obvious to one with ordinary skill in the art at the time of the invention to combine the teachings of **Maxham**, **Koppich**, and **Kenner** with that of **Black** because all of the references are related to data file processing and by including the teachings of file type extension and binary file header teachings of **Kenner**, the method is able to become more secure and robust by not allowing file types to be ignored because they were improperly changed. It is for this reason that one of ordinary skill in the art would have been motivated to

include said step of processing with a prioritization scheme keyed to file type comprises at least one of: identifying a file type extension; and evaluating a binary file header.

52. Regarding claim 34 the combination of **Maxham, Koppich, Kenner, and Black** discloses said step of processing with a prioritization scheme keyed to file type comprises one of: identifying said file type extension and evaluating the binary header when the file type extension is unknown (See **Black** page 4, paragraph [0060] “Most file contain embedded binary data that can be used to identify the file regardless of the file extension.” This means it could determine the type even if the extension was unknown.); and evaluating the binary header, and if there is a conflict between the binary header and the file-type extension, one of the binary header or the file-type extension is considered a default first choice, either arbitrarily or based on a predetermined logic keyed to a predetermined file type. (See **Black** page 4, paragraph [0060] “This is a measure that prevents one from renaming a DOC, XLS, etc. to intentionally hide data or unintentionally omit data files.” Here the conflict would exist between the header and the extension. In this case, it appears the reference chooses the information in the header type to be the default first choice.)

53. Claim 36 is rejected under 35 U.S.C. 103(a) as being unpatentable over **Maxham** in view of **Koppich** and in view of **Kenner** as applied to claim 29 above, and further in view of **McIver** (John McIver, “AutoVue Solid Model Professional Version 15 – Review”

<http://www.cadinfo.net/reviews/AutoVUESolid.htm>, retrieved version dated February 2, 2003).

Maxham, Koppich, and Kenner teach a method substantially as claimed. **Maxham, Koppich,**

and **Kenner** do not explicitly disclose said step of processing with a prioritization scheme keyed to file type comprises: reading a file that is not correlated to a plug-in or a file that cannot be read by a plug-in with an AutoVue plug-in. However, **McIver** discloses said step of processing with a prioritization scheme keyed to file type comprises: reading a file that is not correlated to a plug-in or a file that cannot be read by a plug-in with an AutoVue plug-in. (See page 3, second paragraph "AutoVue claims support for over 190 file formats....a broad range of Vector graphics, Fax, Word Processor, Database and Spreadsheet formats are also covered.") It would have been obvious to one with ordinary skill in the art at the time of the invention to combine the teachings of **Maxham**, **Koppich**, and **Kenner** with that of **McIver** because they are all related to document processing and by including the AutoVue teachings of **McIver**, the system becomes more robust by allowing for a wide variety of files to be processed than without AutoVue. It is for this reason that one of ordinary skill in the art would have been motivated to include said step of processing with a prioritization scheme keyed to file type comprises: reading a file that is not correlated to a plug-in or a file that cannot be read by a plug-in with an AutoVue plug-in.

54. Claim 37 is rejected under 35 U.S.C. 103(a) as being unpatentable over **Maxham** in view of **Koppich** in view of **Kenner** and in view of **McIver** as applied to claim 36 above, and further in view of **Windows Tips** ("Windows Tips – How to create a file association for your programs, using the registry" http://phi.lho.free.fr/windows_tips/FileAssociations.en.html, dated 3 June 1999). **Maxham**, **Koppich**, **Kenner**, and **McIver** teach a method substantially as claimed. **Maxham**, **Koppich**, **Kenner**, and **McIver** do not explicitly disclose said step of processing with a prioritization scheme keyed to a file type comprises: reading a file that cannot be processed by

the AutoVue plug-in by using a Microsoft Windows File Type Association and accessing a Windows registry to determine if a "print" verb is associated with the extension in windows; if said "print" verb is found to be associated with the extension, starting a new Windows process with said "print" verb as startup information and feeding the output of said new Windows process to an imaging print driver.

However, **Windows Tips** discloses said step of processing with a prioritization scheme keyed to a file type comprises: reading a file that cannot be processed by the AutoVue plug-in by using a Microsoft Windows File Type Association and accessing a Windows registry to determine if a "print" verb is associated with the extension in windows; if said "print" verb is found to be associated with the extension, starting a new Windows process with said "print" verb as startup information and feeding the output of said new Windows process to an imaging print driver. (See page 2, line 10 and 11, where the print verb is associated in the registry to the plug-in wordpad.exe)

It would have been obvious to one with ordinary skill in the art at the time of the invention to combine the teachings of **Maxham, Koppich, Kenner, and McIver** with that of **Windows Tips** because the references are related to document processing and by including the File Type Association disclosure as taught in **Windows Tips**, the method becomes more robust by allowing the registry control to determine what plug-in to use in case it is not previously able to be determined. It is for this reason that one of ordinary skill in the art would have been motivated to include said step of processing with a prioritization scheme keyed to a file type comprises: reading a file that cannot be processed by the AutoVue plug-in by using a Microsoft Windows File Type Association and accessing a Windows registry to determine if a "print" verb

is associated with the extension in windows; if said "print" verb is found to be associated with the extension, starting a new Windows process with said "print" verb as startup information and feeding the output of said new Windows process to an imaging print driver.

Response to Arguments

55. Applicant's arguments filed 3/2/07 have been fully considered but they are not persuasive. Applicant's assert the following (lettered):

A. Applicant's assert that the declaration of prior invention under 37 C.F.R. 1.131 establishing a date of conception, coupled with due diligence, starting prior to January 8, 2003, which is the filing date for provisional application 60/438508, which is the priority document for U.S. Patent Publication 20050141028. Thereby concluding that Maxham is not available as a reference under 35 U.S.C. 102 and 103.

In response, according to MPEP 1.131:

§ 1.131 Affidavit or declaration of prior invention.

(a) When any claim of an application or a patent under reexamination is rejected, the inventor of the subject matter of the rejected claim, the owner of the patent under reexamination, or the party qualified under §§ 1.42, 1.43, or 1.47, may submit an appropriate oath or declaration to establish invention of the subject matter of the rejected claim prior to the effective date of the reference or activity on which the rejection is based. The effective date of a U.S. patent, U.S. patent application publication, or international application publication under PCT Article 21(2) is the earlier of its publication date or date that it is effective as a reference under 35 U.S.C. 102(e). Prior invention may not be established under this section in any country other than the United States, a NAFTA country, or a WTO member country. Prior invention may not be established under this section

before December 8, 1993, in a NAFTA country other than the United States, or before January 1, 1996, in a WTO member country other than a NAFTA country. Prior invention may not be established under this section if either:

(1) The rejection is based upon a U.S. patent or U.S. patent application publication of a pending or patented application to another or others which claims the same patentable invention as defined in § 41.203(a) of this title, in which case an applicant may suggest an interference pursuant to § 41.202(a) of this title; or

(2) The rejection is based upon a statutory bar.

*(b) The showing of facts shall be such, in character and weight, as to establish reduction to practice prior to the effective date of the reference, or **conception of the invention prior to the effective date of the reference coupled with due diligence from prior to said date to a subsequent reduction to practice or to the filing of the application. Original exhibits of drawings or records, or photocopies thereof, must accompany and form part of the affidavit or declaration or their absence must be satisfactorily explained.***

[24 FR 10332, Dec. 22, 1959; 34 FR 18857, Nov. 26, 1969; para. (a), 48 FR 2713, Jan. 20, 1983, effective Feb. 27, 1983; para. (a), 50 FR 9381, Mar. 7, 1985, effective May 8, 1985; 50 FR 11366, Mar. 21, 1985; 53 FR 23733, June 23, 1988, effective Sept. 12, 1988; para. (a)(1) revised and para. (a)(2) added, 60 FR 21043, May 1, 1995, effective May 31, 1995; para. (a) revised, 61 FR 42790, Aug. 19, 1996, effective Sept. 23, 1996; heading and para. (a) revised, 65 FR 54604, Sept. 8, 2000, effective Sept. 8, 2000; para. (a) revised, 65 FR 57024, Sept. 20, 2000, effective Nov. 29, 2000; para. (a)(1) revised, 69 FR 49959, Aug. 12, 2004, effective Sept. 13, 2004; para. (b) revised, 69 FR 56481, Sept. 21, 2004, effective Oct. 21, 2004]

In regards to the declaration filed on 3/2/07 under 37 CFR 1.131 has been considered but is ineffective to overcome the cited reference (U.S. Patent Application Publication 200401877075 hereafter Maxham).

Based on the evidence supplied, it appears that applicant is relying on conception prior to the effective date of the reference, followed by diligence until the U.S. filing date. However, it is noted that no such exhibits of drawings, records, or photocopies accompany the declaration.

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Nor is the declaration by the inventor, and does not appear to be by the complete owner of the patent for application nor a party qualified under 1.42, 1.43, 1.47. Although, the declaration appears to be written by a co-founder, a co-founder is not necessarily the complete owner of the company nor does a co-founder mean that they still have ownership of the company. It is further noted no diligent effort appears to have been made in order to contact the inventors.

1. As to Conception,

from MPEP 2138.04:

"Conception" [R-5]

Conception has been defined as "the complete performance of the mental part of the inventive act" and it is "the formation in the mind of the inventor of a definite and permanent idea of the complete and operative invention as it is thereafter to be applied in practice...." *Townsend v. Smith*, 36 F.2d 292, 295, 4 USPQ 269, 271 (CCPA 1930). "[C]onception is established when the invention is made sufficiently clear to enable one skilled in the art to reduce it to practice without the exercise of extensive experimentation or the exercise of inventive skill." *Hiatt v. Ziegler*, 179 USPQ 757, 763 (Bd. Pat. Inter. 1973). Conception has also been defined as a disclosure of an invention which enables one skilled in the art to reduce the invention to a practical form without "exercise of the inventive faculty." *Gunter v. Stream*, 573 F.2d 77, 197 USPQ 482 (CCPA 1978). See also *Coleman v. Dines*, 754 F.2d 353, 224 USPQ 857 (Fed. Cir. 1985) (It is settled that **in establishing conception a party must show possession of every feature recited in the count, and that every limitation of the count must have been known to the inventor at the time of the alleged conception. Conception must be proved by corroborating evidence.**); *Hybritech Inc. v. Monoclonal Antibodies Inc.*, 802 F. 2d 1367, 1376, 231 USPQ 81, 87 (Fed. Cir. 1986) (Conception is the "formation in the mind of the inventor, of a definite and permanent idea of the complete and operative invention, as it is hereafter to be applied in practice."); *Hitzeman v. Rutter*, 243 F.3d 1345, 58 USPQ2d 1161 (Fed. Cir. 2001) (Inventor's "hope" that a genetically altered yeast would produce antigen particles having the particle size and sedimentation rates recited in the claims did not establish conception, since the inventor did not show that he had a **"definite and permanent understanding"** as to whether or how, or a reasonable expectation that, the yeast would produce the recited antigen particles.).

*That is to say, the evidence submitted is insufficient to establish a conception of the invention prior to the effective date of the Maxham reference. While conception is the mental part of the inventive act, it **must be capable of proof, such as by demonstrative evidence or by a complete disclosure to another.** Conception is **more than a vague idea** of how to solve a problem. The requisite means themselves and their interaction must also be comprehended. See *Mergenthaler v. Scudder*, 1897 C.D. 724, 81 O.G. 1417 (D.C. Cir. 1897). Conception must be proved by corroborating evidence with definite and permanent understanding. Paragraphs 1-4 of the affidavit merely identify the co-founder of Cricket Technologies, information about the company, hiring Chief of Development and programmers for e-discovery market software products, and a mere statement of "John Martin articulated his vision of the 'Cricket Box'" is insufficient as a complete disclosure. Furthermore, the statements directed to "Cricket box was a new software solution that would allow users to take digital information from any media, search and filter the data by the litigation criteria, and process the relevant files into databases for ultimate review by attorneys" does not provide definite and permanent understanding of the claimed invention, nor does it provide corroborating evidence. These are mere claims, unsupported by facts.*

From MPEP 715.07:

The essential thing to be shown under 37 CFR 1.131 is priority of invention and this may be done by any satisfactory evidence of the fact. FACTS, not conclusions, must be alleged. Evidence in the form of exhibits may accompany the affidavit or declaration. **Each exhibit relied upon should be specifically referred to in the affidavit or declaration, in terms of what it is relied upon to show.**

A general allegation that the invention was completed prior to the date of the reference is not sufficient. *Ex parte Saunders*, 1883 C.D. 23, 23 O.G. 1224 (Comm'r Pat. 1883). Similarly, a declaration by the inventor to the effect that his or her invention was conceived or reduced to practice prior to the reference date, **without a statement of facts demonstrating the correctness of this conclusion, is insufficient to satisfy 37 CFR 1.131.**

When reviewing a 37 CFR 1.131 affidavit or declaration, the examiner must consider all of the evidence presented in its entirety, including the affidavits or declarations and all accompanying exhibits, records and "notes." **An accompanying exhibit need not support all claimed limitations, provided that any missing limitation is supported by the declaration itself.** *Ex parte Ovshinsky*, 10 USPQ2d 1075 (Bd. Pat. App. & Inter. 1989).

The affidavit or declaration and exhibits must clearly explain which facts or data applicant is relying on to show completion of his or her invention prior to the particular date. **Vague and general statements in broad terms about what the exhibits describe along with a general assertion that the exhibits describe a reduction to practice "amounts essentially to mere pleading, unsupported by proof or a showing of facts"** and, thus, does not satisfy the requirements of 37 CFR 1.131(b). *In re Borkowski*, 505 F.2d 713, 184 USPQ 29 (CCPA 1974). **Applicant must give a clear explanation of the exhibits pointing out exactly what facts are established and relied on by applicant.** 505 F.2d at 718-19, 184 USPQ at 33. See also *In re Harry*, 333 F.2d 920, 142 USPQ 164 (CCPA 1964) (Affidavit "asserts that facts exist but does not tell what they are or when they occurred.").

The declaration does not provide enough evidence to support conception of the claimed invention. For example, there is no explanation in a clear statement within the declaration to support the limitations "tagging the working electronic folder with folder meta-data" in claim 2 among other limitations. Applicants did not give a clear explanation pointing out exactly what facts are established and relied upon from the declaration with respect to the particular claim limitations, nor provided any corroborating evidence in support of claims made within the declaration.

The aforementioned limitation in claim 2 merely provides one example of insufficient evidence supporting conception of the claimed invention. It is to be understood that there are other claimed limitations that are not sufficiently supported by the evidence provided by the declaration. Thus, applicant has not met his burden of clearly showing how the submitted evidence supports conception of the invention.

2. *As to Diligence, from MPEP 2138.06,*

**THE ENTIRE PERIOD DURING WHICH DILIGENCE IS REQUIRED
MUST BE ACCOUNTED FOR BY EITHER AFFIRMATIVE ACTS OR
ACCEPTABLE EXCUSES**

An applicant must account for the entire period during which diligence is required. *Gould v. Schawlow*, 363 F.2d 908, 919, 150 USPQ 634, 643 (CCPA 1966) (Merely stating that there were no weeks or months that the invention was not worked on is not enough.); *In re Harry*, 333 F.2d 920, 923, 142 USPQ 164, 166 (CCPA 1964) (**statement that the subject matter "was diligently reduced to practice" is not a showing but a mere pleading**). **A 2-day period lacking activity has been held to be fatal.** *In re Mulder*, 716 F.2d 1542, 1545, 219 USPQ 189, 193 (Fed. Cir. 1983) (37 CFR 1.131 issue); *Fitzgerald v. Arbib*, 268 F.2d 763, 766, 122 USPQ 530, 532 (CCPA 1959) (Less than 1 month of inactivity during critical period. Efforts to exploit an invention commercially do not constitute diligence in reducing it to practice. An actual reduction to practice in the case of a design for a three-dimensional article requires that it should be embodied in some structure other than a mere drawing.); *Kendall v. Searles*, 173 F.2d 986, 993, 81 USPQ 363, 369 (CCPA 1949) (**Diligence requires that applicants must be specific as to dates and facts.**).

The period during which diligence is required must be accounted for by either affirmative acts or acceptable excuses. *Rebstock v. Flouret*, 191 USPQ 342, 345 (Bd. Pat. Inter. 1975); *Rieser v. Williams*, 225 F.2d 419, 423, 118 USPQ 96, 100 (CCPA 1958) (**Being last to reduce to practice, party cannot prevail unless he has shown that he was first to conceive and that he exercised reasonable diligence during the critical period from just prior to opponent's entry into the field**); *Griffith v. Kanamaru*, 816 F.2d 624, 2 USPQ2d 1361 (Fed. Cir. 1987) (Court generally reviewed cases on excuses for inactivity including

vacation extended by ill health and daily job demands, and held lack of university funding and personnel are not acceptable excuses.); *Litchfield v. Eigen*, 535 F.2d 72, 190 USPQ 113 (CCPA 1976) (budgetary limits and availability of animals for testing not sufficiently described); *Morway v. Bondi*, 203 F.2d 741, 749, 97 USPQ 318, 323 (CCPA 1953) (voluntarily laying aside inventive concept in pursuit of other projects is generally not an acceptable excuse although there may be circumstances creating exceptions); *Anderson v. Crowther*, 152 USPQ 504, 512 (Bd. Pat. Inter. 1965) (preparation of routine periodic reports covering all accomplishments of the laboratory insufficient to show diligence); *Wu v. Jucker*, 167 USPQ 467, 472-73 (Bd. Pat. Inter. 1968) (applicant improperly allowed test data sheets to accumulate to a sufficient amount to justify interfering with equipment then in use on another project); *Tucker v. Natta*, 171 USPQ 494, 498 (Bd. Pat. Inter. 1971) ("[a]ctivity directed toward the reduction to practice of a genus does not establish, *prima facie*, diligence toward the reduction to practice of a species embraced by said genus"); *Justus v. Appenzeller*, 177 USPQ 332, 340-1 (Bd. Pat. Inter. 1971) (Although it is possible that patentee could have reduced the invention to practice in a shorter time by relying on stock items rather than by designing a particular piece of hardware, patentee exercised reasonable diligence to secure the required hardware to actually reduce the invention to practice. "[I]n deciding the question of diligence it is immaterial that the inventor may not have taken the expeditious course..").

The affidavit filed on 3/2/07 under 37 CFR 1.131 has been considered but is ineffective to overcome the cited reference. The evidence submitted is insufficient to establish diligence from a date prior to the effective date of the Maxham reference (January 8, 2003) to the US effective filing date of this application (January 30, 2004) because there is at least a period lacking activity. For example, the period from January 8, 2004 to April 12, 2004, demonstrates at least lack of attorney diligence. Furthermore, as to the declaration paragraphs 5-6, in regards to "worked daily on the Cricket Box" from prior to 1/7/2003 to at least 4/11/2003, does not provide any supported evidence to establish diligence.

Conclusion

56. The prior art made of record listed on PTO-892 and not relied, if any, upon is considered pertinent to applicant's disclosure.

Contact Information

57. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Contact Information

58. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael D. Pham whose telephone number is (571)272-3924. The examiner can normally be reached on Monday - Friday 9am - 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Cottingham can be reached on 571-272-7079. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.


Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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